Supreme Court, U.S.
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No. 06-481

IN THE

Supreme Court of the United States

DEBRA LAWS, PETITIONER

v.

SONY MUSIC ENTERTAINMENT, INC., D/B/A EPIC RECORDS, A DELAWARE CORPORATION, RESPONDENT

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

Does Section 301 of the Copyright Act, 17 U.S.C. Section 301, preempt an individual from pursuing a right of publicity claim relating to a work that is subject to copyright?

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OPINIONS BELOW

This petition is from a ruling of the United States Court of Appeals for the Ninth Circuit dated May 24, 2006 which affirmed the decision of the District Court and is officially reported at 448 F.3d 1134. A copy of this ruling has been reproduced in the Appendix at App. 1a.

The lower court decision and order from the United States District Court for the Central District of California dated November 3, 2003, which dismissed Petitioner's complaint is officially reported at 294 F. Supp. 2d 1160 (C.D. Cal 2003) and has been reproduced in the Appendix at App. 25a.

Petitioner sought an *en banc* rehearing of the Ninth Circuit's ruling of May 24, 2006. The Ninth Circuit denied the petition on July 10, 2006. A copy of the Ninth Circuit's unpublished order has been reproduced in the Appendix at App. 37a.

JURISDICTION

This petition is timely pursuant to 28 U.S.C. §2101(c) and United States Supreme Court Rules 13.1 and 13.3 because the petition is being filed within 90 days of the Ninth Circuit's order dated July 10, 2006, which denied Petitioner's Petition for Rehearing or Rehearing *en banc* on the Ninth Circuit's Opinion filed on May 24, 2006.

RELEVANT PROVISIONS INVOLVED

The relevant statutory provision is 17 U.S.C. §301 of the 1976 Copyright Act.

STATEMENT

On May 24, 2006, the Ninth Circuit affirmed the District Court's summary judgment ruling in favor of Respondent Sony Music Entertainment, Inc. ("Sony") on Petitioner Laws' causes of action for violation of her statutory and common law right of publicity.

This petition is being brought on the grounds that the Ninth Circuit's opinion, which found that Petitioner Laws' right of publicity claims were preempted by Section 301 of the Copyright Act, directly contradicts: (1) a holding of this Court (*Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977)), (2) the Seventh Circuit's recent opinion in *Toney v. L'Oreal, USA, Inc.*, 406 F.3d 905 (7th Cir. 2005), and (3) other decisions of the Ninth Circuit (*Midler v. Ford Motor Company*, 849 F.2d 460 (9th Cir. 1988) and *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) cert. denied, 506 U.S. 1080 (1993). This petition raises an exceptional question of national impact for which there is an overriding need for national uniformity, which warrants review by the United States Supreme Court.

If the Ninth Circuit's decision in this case is allowed to stand, then nothing stops third parties motivated by commercial gain from licensing copyrighted pictures of the Justices of this Court and imposing those pictures as the faces of actors in pornographic films.

Background Facts

In 1979, Petitioner Laws, a professional vocalist and recording artist, signed an exclusive production agreement (the "Laws/Spirit Agreement") with a

company named Spirit Productions ("Spirit"). Spirit immediately thereafter entered into a recording agreement (the "Spirit/Elektra Agreement") with Elektra/Asylum Records ("Elektra") to produce master recordings of Petitioner Laws' vocal performances for Elektra. The Laws/Spirit Agreement gave Spirit all rights to the copyright in the recording by Petitioner Laws. In turn, the Spirit/Elektra Agreement gave Elektra the "sole exclusive right to copyright such masters." The Laws/Spirit Agreement and the Spirit/Elektra Agreement, contained two identical provisions central to the issues in this case, which provided that: (1) "we shall not, without your prior written consent, utilize or authorize others to utilize the masters in any so-called 'audio visual' or 'sight and sound' devices intended primarily for home use," and (2) "'we or our licensees' shall not, without your prior written consent, sell records embodying the masters hereunder for use as premiums or in connection with the sale, advertisement or promotion of any other product or service." (collectively, the "Limitation Provision"). It was not contested by Sony that the Limitation Provision precluded Elektra or its licensees from using Petitioner Laws' vocal masters in music samples or music videos without the consent of Petitioner Laws. The Laws album was a major hit, and the song "Very Special" is an established R&B Classic that is still played on R&B, Jazz and Hip Hop music stations throughout the United States.

In November, 2002, Elektra's agent, Warner Special Products, Inc. ("Warner"), entered into an agreement with Sony to grant Sony a non-exclusive license to use a sample of Petitioner Laws' recording of "Very Special" in the rap version of the song re-titled "All I Have," performed by recording artists Jennifer

Lopez and LL Cool J. Warner did not seek permission from Spirit and, in turn, Spirit did not seek consent from Laws before Sony released the disc and video, and neither Laws nor Spirit were compensated for this use. It is undisputed that this use violated the Limitation Provision.

The Jennifer Lopez compact disc and music video incorporates samples of Laws' "Very Special" into her recording of "All I Have". The sampled portion includes the segment that specifically incorporates Petitioner Laws' widely known principal stanza or hook of "Very Special." This refrain is repeated throughout the song "All I Have". Sony also included Petitioner Laws' name on the booklet accompanying the compact disc. The song "All I Have", contained on the Lopez album "This is Me Then...", was a huge commercial success generating over $40 million dollars in sales. Sampling Petitioner Laws' sound recording helped promote the Lopez CD and gave the false impression that Petitioner Laws endorsed the Lopez rap version of the song.

REASONS FOR GRANTING THE PETITION

I. A DIRECT CONFLICT EXISTS BETWEEN CIRCUIT COURTS

The Ninth Circuit decision in the instant action directly contradicts (a) a holding of this Court *(Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977)), (b) the Seventh Circuit's recent opinion in *Toney v. L' Oreal, U.S.A., Inc.* 406 F.3d 905 (7th Cir. 2005) and (c) other decisions of the Ninth Circuit *(Midler v. Ford Motor Company*, 849 F. 2d 460

(9th Cir. 1988) and *Waits v. Frito-Lay, Inc.* 978 F. 2d 1093 (9th Cir. 1992) cert. denied, 506 U.S. 1080 (1993)).

In *Toney*, the plaintiff was a model who had consented to allow her photograph to be used for commercial purposes for a defined period of time. Plaintiff brought suit against defendants, who were the copyright owners of the photograph, under the Illinois Right of Publicity Act ("IRPA"), after defendants had used her picture in commercials without her consent after the term of use had elapsed. Similar to Petitioner Laws, the Plaintiff in *Toney* claimed no copyright interest in the photo at issue, and the defendant's principal defense rested on the exact same premise used against Petitioner Laws – that the law of copyright preempted a state claim based on the right of publicity. In determining that Plaintiff Toney's right of publicity claim did not clash with the law of copyright, the Seventh Circuit analyzed this issue in a far more sophisticated and reasoned manner than the Ninth Circuit adopted in *Laws*. The *Toney* Court began its analysis by considering the contours of the statute itself:

> "The IRPA states that a person's 'identity' is protected by the statute. Identity is defined to mean 'any attribute of an individual that serves to identify that individual to an ordinary, reasonable viewer or listener, including but not limited to (i) name, (ii) signature, (iii) photograph, (iv) image, (v) likeness, or (vi) voice.' 765 Ill. Comp. Stat. 1075/5. In short, the IRPA protects a person's right to publicity. The subject matter of such a claim 'is not a particular picture or photograph of plaintiff. Rather, what is protected by the right

> of publicity is the very identity or persona of the plaintiff as a human being.'

J. Thomas McCarthy, 2 Rts of Publicity & Privacy, 11:52 (2d ed. 2004) [emphasis in original] [internal citations and quotations omitted]." *Toney*, 406 F.3d at 908.

In ruling in favor of Plaintiff Toney, the Seventh Circuit looked to the essential elements of a right of publicity claim and why this claim must survive challenge by preemption, if the right is to exist at all under any state law:

> "...we find that Toney's identity is not fixed in a tangible medium of expression. There is no 'work of authorship' at issue in Toney's right of publicity claim. **A person's likeness – her persona – is not authored and it is not fixed. The fact that an image of the person might be fixed in a copyrightable photograph does not change this. From this we must also find that the rights protected by the IRPA are not 'equivalent' to any of the exclusive rights within the general scope of copyright that are set forth in § 106.** Copyright laws do not reach identity claims such as Toney's. Identity, as we have described it, is an amorphous concept that is not protected by copyright law; thus, the state law protecting it is not preempted."

Toney, 406 F.3d at 910. [Emphasis added.]

The Court in *Toney* correctly found that the Illinois counterpart to California Civil Code §3344, was not equivalent to copyright law. The right of

publicity exists wholly independently from the rights protected by copyright.

Consent to use of one's right of publicity for one purpose is not deemed consent to another. The *Toney* Court concluded that:

> "The fact that Toney consented to the use of her photograph originally does not change this analysis. The defendants did not have her consent to continue to use the photograph and, therefore, they stripped Toney of her right to control the commercial value of her identity."

Toney, 406 F.3d at 910.

Toney involved an image embedded in a copyrighted photo. IRPA is identical to California Civil Code §3344 in all material respects. *Laws* involved a voice embedded in a copyrighted sound recording. Toney had a reservation of rights to exploit her photo after a defined contractual period. Petitioner Laws had a reservation of rights to exploit her voice in connection with any other product (including, but not limited to, another album or video). Because the Ninth Circuit's decision in *Laws* cannot be reconciled with the Seventh Circuit's ruling in *Toney*, the decisions create a direct conflict between the two Circuits concerning an important question of federal law, namely, the extent to which copyright law may usurp the ability of a state to create statutes designed to protect an individual's right of publicity.

The *Laws* opinion itself implicitly recognizes the conflict by stating (in a footnote) that "[w]e express no views on the correctness of *Toney* or its application to any claims against Elektra." App. at 24a, n. 4. If the right of publicity is to remain a viable claim, then the

discordance which now exists between the Seventh and Ninth Circuits cannot be sanctioned and must be resolved by the United States Supreme Court.

In *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), the Court's opinion centered on the "protectibility of the voice of a celebrated chanteuse from commercial exploitation without her consent". *Midler* 849 F.2d at 461. In *Midler*, the Ninth Circuit held that an imitative vocalist infringed on the right of publicity held by Bette Midler to exploit her own voice. The reasoning underlying *Midler* is equally applicable in the instant case. As stated in the *Midler* decision:

> "[i]f Midler were claiming a secondary meaning to "Do You Want to Dance" or seeking to prevent the defendants from using that song, she would fail. But that is not the case. Midler does not seek damages for Ford's use of "Do You Want to Dance," and thus her claim is not preempted by federal copyright law. Copyright protects "original works of authorship fixed in any tangible medium of expression."

17 U.S.C. § 102(a). A voice is not copyrightable. The sounds are not fixed." *Midler*, 849 F.2d at 462.

The Ninth Circuit in *Laws* goes to great lengths to draw a distinction between an imitative voice, as in *Midler*, and an actual voice embedded in a sound recording, as in *Laws*, but this distinction is wholly irrelevant. In Thomas McCarthy's authoritative treatise entitled The Right of Publicity and Privacy (2006), the author expressly criticizes the artificial distinction which was erected in *Laws* to separate this ruling from that of *Midler*:

> "Some district courts in California distinguished *Midler* where there was no commercialized imitation of voice, but a use of the Plaintiff's voice in a sound recording used under license from the copyright holder. The courts in those cases held that there was federal preemption of the right of publicity claim on the logic that a voice *per se* cannot be copyrighted, but a voice fixed in a sound recording can. **In the author's opinion, t ose district court cases are in error because they slide over the fact that the right of publicity claims are for a commercial appropriation of the plaintiff's non-copyrightable identity, which identity happened to be identified by their recorded voice. It should make no difference whether the defendant imitated the identity by a sound-alike performer or took it directly from a sound recording. In neither case is there preemption by copyright law."**

J. Thomas McCarthy, Right of Publicity and Privacy Section 11:59, p. 787 (2006). [emphasis added]

Similarly, the Ninth Circuit's opinion in *Laws* also places it squarely in conflict with another opinion rendered by the same Court in *Waits v. Frito-Lay, Inc.* 978 F. 2d 1093 (9th Cir. 1992) cert. denied, 506 U.S. 1080. In *Waits*, recording artist and actor Tom Waits brought a right of publicity claim against Frito-Lay for using an imitation of his voice in a commercial. The Ninth Circuit opinion rendered in favor of Plaintiff Waits emphasized that "Waits' voice misappropriation claim is one for invasion of a personal property right: his *right of publicity to control the use of his identity as*

embedded in his voice". *Waits*, 978 F.2d at 1100. The same principle is equally applicable in the case of *Laws* but was not followed by the Ninth Circuit. As the Ninth Circuit articulated in *Midler*, "what is put forward as protectable here is more personal than any work of authorship...a voice is as distinctive and personal as a face". *Midler*, 849 F.2d at 462-63. What Petitioner Laws sought to protect in her action is every bit as protectable as that which was at stake in *Zacchini*, *Toney*, *Midler* or *Waits* and must be recognized in the same manner.

The right of publicity is a right recognized by common law, statute, or both, in more than half of the United States. Goldstein on Copyright, Section 17.17 (2005). It protects an individual against unauthorized use of his name, voice, likeness, or other elements of his persona, in the absence of an applicable defense. These rights inevitably can be violated by works subject to copyright. It is critical, especially for those working in the entertainment industry, to have a clear understanding of these rights so that they may exercise and defend them appropriately.

A majority of circuit courts have expressly rejected the proposition articulated by the Ninth Circuit in the *Laws* decision, that is, that a person's voice, name or likeness may be the subject of copyright once it is embodied in a copyrightable work. See, *Brown v. Ames*, 201 F.3d 654 (5th Cir. 2000); *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619 (6th Cir. 2000); *Wendt v. Host International, Inc.*, 125 F.3d 806 (9th Cir. 1997); *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001).

Furthermore, as explained in Nimmer's seminal treatise on the law of copyright:

> "the "work" that is the subject of the right of publicity is the persona, i.e., the name and likeness of a celebrity or other individual. A persona can hardly be said to constitute a "writing" of an "author" within the meaning of the copyright clause of the constitution. A fortori, it is not a "work of authorship" under the act. Such name and likeness will not become the work of authorship simply because they are embodied in a copyrightable work such as a photograph."

Nimmer on Copyright, Section 1.01[B][1][c] at 1-28 [2006]

The fact that the subject matter of a right of publicity claim (such as the name, voice or likeness of petitioner) may be embodied in a separate work of authorship, such as a picture or sound recording, does not transform the name, voice or likeness into a fixed work of authorship within the subject matter of copyright under Section 102 of the Copyright Act. *Brown*, 201 F. 3d at 658; *Downing*, 265 F. 3d at 1004. In other words, simply because a person's likeness or voice can be embodied in a work of authorship, such as a sound recording, does not make the voice itself a fixed work of authorship within the subject matter of copyright any more than painting a picture of the Grand Canyon makes the Grand Canyon itself (as opposed to the painting) a work of authorship within the subject matter of copyright.

II. THE *LAWS* OPINION DIRECTLY CONTRADICTS THE U.S. SUPREME COURT'S PRIOR RULING IN *ZACCHINI V. SCRIPPS-HOWARD BROADCASTING CO.*

The United States Supreme Court has considered the constitutionality of the right of publicity on only one previous occasion. In 1977 this Court affirmed the viability of the right of publicity in the case of *Zacchini v. Scripps – Howard Broadcasting Company*, 433 U.S. 562 (1977). In *Zacchini*, a human cannonball performer sued a news station for filming and broadcasting his circus act in violation of his right of publicity. The U.S. Supreme Court rejected the defendant's First Amendment defense and held that the plaintiff possessed a valid right of publicity. The Ninth Circuit's ruling in *Laws* directly conflicts with *Zacchini*, since the plaintiff in that case would have lost under the Ninth Circuit's analysis because the broadcaster owned the copyright to the videotape of the cannonball act. In *Zacchini*, this Court opined on the constitutionality of the right of publicity while also acknowledging the common terrain upon which both copyright and the right of publicity tread:

> "The State's interest in permitting a 'right of publicity' is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment. The State's interest is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his reputation."

Zacchini, 433 U.S. at 572.

The Court went on to conclude that

> "[t]he rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of goodwill. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay. Kalvin, 'Privacy in Tort Law – Were Warren and Brandeis Wrong?' 31 Law & Contemp. Probs. 326, 331 (1966)."

Zacchini, 433 U.S. at 576.

The critical question raised by this petition has never been considered by this Court, namely, whether Section 301 of the Copyright Act should preempt a state-created right of publicity claim based on the use of an artist's name and voice in a work not consented to by the artist. Under the terms of Section 301, a state cause of action is preempted only if it creates rights that are equivalent to any of the exclusive rights of copyright in works of authorship that are fixed in a tangible form and fall within the subject matter of copyright. Thus, Section 301 requires two conditions to be met for preemption – the grant of an equivalent right and the presence of a fixed work of authorship. What constitutes equivalency when measuring the contours of the right of publicity against the laws of copyright and how one defines a "fixed work of authorship" are questions which were never considered as part of the *Zacchini* opinion and lie at the heart of a fierce debate among circuit courts today. The court in *Toney* correctly analyzed that the IRPA, like California

Civil Code §3344, was not equivalent to copyright law. The right of publicity protects different rights than copyright and should no more be preempted than a defamation claim based on a work subject to copyright.

The danger of the Laws precedent cannot be overstated since, if left to stand, it would allow the name, voice or likeness of any person to be used without that person's consent on any licensed work that is subject to copyright. For example, application of this ruling would allow third parties to license copyrighted pictures (or voice) of the Justices of this Court and impose those pictures as the faces of actors in pornographic films for commercial gain. This is simply not within the intended scope of copyright. The Copyright Act was designed to protect authors and owners of a work, while the right of publicity protects the subjects of a work. If the right of publicity is going to have true vitality and exist as more than just an abstract principle, intervention by the United States Supreme Court is both critical and necessary to give guidance to lower courts in regard to this important issue. This case should be remanded to District Court for trial on the merits.

CONCLUSION

For all of the foregoing reasons, Petitioner Laws respectfully requests that the Court grant this Petition for Writ of Certiorari.

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No. 03-57102

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

DEBRA LAWS,
Plaintiff-Appellant,

v.

SONY MUSIC ENTERTAINMENT, INC., d/b/a
EPIC RECORDS, a Delaware corporation,
Defendant-Appellee.

September 12, 2005, Argued and Submitted

May 24, 2006, Filed

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JUDGES: Before: Jerome Farris, Ferdinand F. Fernandez, and Jay S. Bybee, Circuit Judges. Opinion by Judge Bybee.

OPINION BY: BYBEE

OPINION: BYBEE, Circuit Judge:

Plaintiff Debra Laws ("Laws") brought suit against defendant Sony Music Entertainment, Inc. ("Sony") for misappropriating her voice and name in the song "All I Have" by Jennifer Lopez and L.L. Cool J. The district court found that Sony had obtained a license to use a sample of Laws's recording of "Very Special" and held that Laws's claims for violation of her common law right to privacy and her statutory right of publicity were preempted by the Copyright Act, 17 U.S.C. § 101-1332. We agree with the district court that the Copyright Act preempts Laws's claims, and we affirm.

I. FACTS AND PROCEEDINGS

In 1979, professional vocalist and recording artist Debra Laws and Spirit Productions ("Spirit") entered into a recording agreement with Elektra/Asylum Records ("Elektra") to produce master recordings of Laws's vocal performances for Elektra. The agreement gave Elektra the "sole and exclusive right to copyright such master recordings" and "the exclusive worldwide right in perpetuity . . . to lease, license, convey or otherwise use or dispose of such master recordings." Elektra also secured the right "to use and to permit others to use your name, the Artist's name . . . likeness, other identification, and biographical material concerning the Artist . . . in connection with such master recordings." Notwithstanding these provisions, Elektra agreed that "we shall not, without your prior written consent, utilize or authorize others to utilize the Masters in any so-called 'audio-visual' or 'sight and sound' devices intended primarily for home use," and "we or our licensees shall not, without your prior written consent, sell records embodying the Masters hereunder for use as premiums or in connection with

the sale, advertising or promotion of any other product or service." In 1981, Laws recorded the song "Very Special," which was released on Laws's album on the Elektra label. Elektra copyrighted the song that same year.

In November 2002, Elektra's agent, Warner Special Products, Inc., entered into an agreement with Sony Music Entertainment, Inc. ("Sony") to grant Sony a non-exclusive license to use a sample of Debra Laws's recording of "Very Special" in the song "All I Have," performed by recording artists Jennifer Lopez and L.L. Cool J. The agreement required Sony to include a credit stating, "Featuring samples from the Debra Laws recording 'Very Special' " in any reproduction. Warner, Elektra's agent, did not seek permission from Laws or Spirit before it released the disc and video, and neither Laws nor Spirit was compensated.

Sony subsequently released a Jennifer Lopez compact disc and music video incorporating brief samples of "Very Special" into her recording of "All I Have." The sampled portions include a segment approximately ten seconds in length at the beginning of "All I Have," and shorter segments repeated in the background throughout the song. Sony included the required credit in the booklet accompanying the compact disc. The song and Lopez's album, "This is Me . . . Then," became a huge commercial success, netting over forty-million dollars. At one time "All I Have" was the number one song in the United States.

In February 2003, Laws brought an action in the Superior Court of California, County of Los Angeles, alleging multiple claims. The two claims relevant to this

appeal were: (1) a common law claim for invasion of privacy for the misappropriation of Laws's name and voice and (2) a claim for misappropriation of Laws's name and voice for a commercial purpose under California Civil Code § 3344. The complaint sought injunctive and monetary relief.

Sony removed the case to the United States District Court for the Central District of California and sought to join Elektra as a necessary party. The court denied the motion. Sony filed a summary judgment motion, which the district court granted, ruling that both of Laws's misappropriation claims were preempted by the Copyright Act. Laws filed a timely appeal.

II. STANDARD OF REVIEW

A grant of summary judgment is reviewed de novo. *See Buono v. Norton*, 371 F.3d 543, 545 (9th Cir. 2004). We must view the evidence in the light most favorable to Laws and determine whether there is any genuine issue of material fact and whether the district court properly applied the relevant substantive law. *See Olsen v. Idaho State Bd. of Med.*, 363 F.3d 916, 922 (9th Cir. 2004). Summary judgment may be affirmed on any ground supported by the record. *Id.*

We review de novo whether a federal law preempts a state law. *See Radici v. Associated Ins. Cos.*, 217 F.3d 737, 740 (9th Cir. 2000). The district court's interpretation of state law is also reviewed de novo. *See Rabkin v. Or. Health Scis. Univ.*, 350 F.3d 967, 970 (9th Cir. 2003).

III. ANALYSIS

The Copyright Clause of the U. S. Constitution provides that "Congress shall have the Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . ." U.S. Const. art. I, § 8, cl. 8. Pursuant to this authority, Congress enacted the Copyright Act, 17 U.S.C. § 101-1332, to define and protect the rights of copyright holders. Under the Act, "the owner of copyright . . . has the exclusive rights to do and to authorize" others to display, perform, reproduce or distribute copies of the work, and to prepare derivative works. *Id.* § 106. The copyright is the right to control the work, including the decision to make the work available to or withhold it from the public.

Sections 301(a) and (b) of Title 17 describe when the Act preempts legal and equitable rights granted by state common law or statute. Section (a) states:

> On and after January 1, 1978, all legal and equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

Id. § 301(a). Section (b) states:

Nothing in this title annuls or limits any rights or

remedies under the common law or statutes of any State with respect to . . . subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression . . . .

Id. § 301(b) (2000). Congress explained what the statute made obvious: "[t]he intention of section 301 is to preempt and abolish any rights under the common law or statutes of a State that are equivalent to copyright and that extend to works, within the scope of the Federal copyright law." H.R. Rep. No. 94-1476, at 130 (1976); *see also Maljack Prods. v. GoodTimes Home Video Corp.*, 81 F.3d 881, 888 (9th Cir. 1996).

We have adopted a two-part test to determine whether a state law claim is preempted by the Act. We must first determine whether the "subject matter" of the state law claim falls within the subject matter of copyright as described in 17 U.S.C. §§ 102[1] and 103.[2] Second, assuming that it does, we must determine whether the rights asserted under state law are equivalent to the rights contained in 17 U.S.C. § 106, which articulates the exclusive rights of copyright holders.[3] *See Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003 (9th Cir. 2001).

Laws alleges two causes of action. First, she asserts a claim for protection of her voice, name and likeness under California's common law right of privacy. To sustain this action, Laws must prove: "(1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury." *Eastwood v.*

Superior Court, 149 Cal. App. 3d 409, 198 Cal. Rptr. 342, 347 (Ct. App. 1983), *superseded by statute on other grounds as stated in KNB Enters. v. Matthews*, 78 Cal. App. 4th 362, 92 Cal. Rptr. 2d 713 (Ct. App. 2000); *see also Downing*, 265 F.3d at 1001. Second, Laws asserts a statutory misappropriation or "right of publicity" claim under California Civil Code § 3344(a), which provides that:

> Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.

We have observed that "[t]he remedies provided for under California Civil Code § 3344 complement the common law cause of action; they do not replace or codify the common law." *Downing*, 265 F.3d at 1001. Nevertheless, for purposes of our preemption analysis, section 3344 includes the elements of the common law cause of action. *See id.* ("Under section 3344, a plaintiff must prove all the elements of the common law cause of action" plus "knowing use" and "a direct connection between the alleged use and the commercial purpose."). For convenience's sake, we will refer to Laws's claims as "right of publicity" claims.

Sony does not argue that common law privacy actions and statutory claims under section 3344 are preempted generally by section 301; rather, it argues that they are

preempted as applied to the facts of this case. We thus turn to (1) whether the subject matter of Laws's right of publicity claims comes within the subject matter of copyright, and (2) whether the rights Laws asserts under California law are equivalent to those created under the Copyright Act.

A. *The "Subject Matter" of Copyright*

We first consider whether the subject matter of Laws's misappropriation claim is within the subject matter of the Copyright Act. We conclude that it is. Sections 102 and 103 of the Act identify the works of authorship that constitute the "subject matter" of copyright. Section 102 of the Act extends copyright protection to "original works of authorship fixed in any tangible medium of expression . . . from which they can be . . . reproduced, . . . either directly or with the aid of a machine or device." 17 U.S.C. § 102(a). That section defines a "work of authorship" to include "sound recordings." *Id.* § 102(a)(7). "A work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." *Id.* § 101. Laws's master recordings held by Elektra are plainly within these definitions.

Laws nevertheless contends that the subject matter of a copyright claim and a right of publicity claim are substantively different. She argues that a copyright claim protects ownership rights to a work of art, while a right of publicity claim concerns the right to protect one's persona and likeness. Sony, by contrast, contends

that the subject matter of a right of publicity in one's voice is not different from a copyright claim when the voice is embodied within a copyrighted sound recording. Sony argues that once a voice becomes part of a sound recording in a fixed tangible medium it comes within the subject matter of copyright law.

Our jurisprudence provides strong guidance to the resolution of this question. In *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970), Nancy Sinatra filed suit against Goodyear Tire on the basis of an advertising campaign that featured "These Boots Are Made for Walkin'," a song that Sinatra made famous. Goodyear Tire had obtained a license from the copyright proprietor for the use of music, lyrics, and arrangement of the composition. Goodyear Tire subsequently used the music and lyrics in its ads, which were sung by unknown vocalists. She alleged the song had taken on a "secondary meaning" that was uniquely injurious to her. We rejected her claim:

> [A]ppellant's complaint is not that her sound is uniquely personal; it is that the sound in connection with the music, lyrics and arrangement, which made her the subject of popular identification, ought to be protected. But as to these latter copyrightable items she had no rights. Presumably, she was required to obtain permission of the copyright owner to sing "Boots", and to make an arrangement of the song to suit her own tastes and talents. Had she desired to exclude all others from use of the song so that her "secondary meaning" with the song could not be imitated she could have purchased those rights from the copyright proprietor. One

> wonders whether her voice . . . would have been identifiable if another song had been presented, and not "her song," which unfortunately for her was owned by others and licensed to the defendants.

Id. at 716. Although *Sinatra* was decided prior to passage of the modern-day preemption provision in section 301, we nonetheless ruled that the Copyright Act impliedly preempted Sinatra's state law claim. *Id.* at 717-18. We later confirmed this holding in *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988), when we observed that "[t]o give Sinatra damages for [defendants'] use of the song would clash with federal copyright law."

In *Midler*, recording and performing artist Bette Midler filed suit against an advertising agency and its client when a professional "sound alike" was used to imitate Midler's voice from her hit song "Do You Want to Dance." The agency did not acquire a license to use Midler's recording; instead, it had obtained a license from the song's copyright holder and then attempted to get Midler to do the commercial. When Midler's agent advised the agency that she was not interested, the agency hired someone who had been a backup singer for Midler and could imitate her voice and style. Indeed, the singer was instructed to sound as much like Bette Midler as possible. We held that Midler's common law misappropriation claim was not preempted by copyright law because the "thing" misappropriated, her voice, was not copyrightable in that instance. We explained:

> Midler does not seek damages for [the defendant's] use of "Do You Want To Dance," and thus her claim is not preempted by federal copyright law. Copyright protects "original works of authorship fixed in any tangible medium of expression. " A voice is not copyrightable. The sounds are not "fixed." What is put forward as protectible here is more personal than any work of authorship.

Id. at 462 (citation omitted). What Midler sought was relief from an unauthorized vocal imitation for advertising purposes, and that was not the subject of copyright.

We subsequently applied *Midler* in *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992). The voice of Tom Waits, a professional singer, songwriter, and actor, was imitated and then broadcast in a commercial for Frito-Lay. Waits filed a right of publicity claim under California law. We held that the claim was not preempted by copyright law because it was "for infringement of voice, not for infringement of a copyrightable subject such as sound recording or musical composition." *Id.* at 1100. Thus, the issues in *Waits* were "whether the defendants had deliberately imitated Waits" voice rather than simply his style and whether Waits' voice was sufficiently distinctive and widely known to give him a protectible right in its use. These elements are 'different in kind' from those in a copyright infringement case challenging the unauthorized use of a song or recording." *Id.*

In this case, Laws's voice misappropriation claim is plainly different from the claims in *Midler* and *Waits*

and falls within the subject matter of copyright. In contrast to *Midler* and *Waits*, where the licensing party obtained only a license to the song and then imitated the artist's voice, here Sony obtained a license to use Laws's recording itself. Sony was not imitating "Very Special" as Laws might have sung it. Rather, it used a portion of "Very Special" as sung by Debra Laws. *See also Brown v. Ames*, 201 F.3d 654, 658 (5th Cir. 2000) ("The crucial difference between [this case and *Daboub v. Gibbons*, 42 F.3d 285 (5th Cir. 1995)] is that in *Daboub* the basis of the misappropriation claim . . . was the song itself, bringing it within section 301's ambit, whereas here the basis of the misappropriation claim was defendants' use of plaintiffs' names and/or likenesses.").

Laws does not dispute Sony' contention that the recording of "Very Special" was a copyrighted sound recording fixed in a tangible medium of expression. Laws' right of publicity claim is based exclusively on what she claims is an unauthorized duplication of her vocal performance of the song "Very Special." Although California law recognizes an assertable interest in the publicity associated with one' voice, we think it is clear that federal copyright law preempts a claim alleging misappropriation of one's voice when the entirety of the allegedly misappropriated vocal performance is contained within a copyrighted medium. Our conclusion is consistent with our holdings in *Midler* and *Waits*, where we concluded that the voice misappropriation claim was not preempted, because the alleged misappropriation was the imitation of the plaintiffs' voices. Neither of those imitations was contained in a copyrighted vocal performance. Moreover, the fact that the vocal performance was copyrighted demonstrates

that what is put forth here as protectible is *not* "more personal than any work of authorship." *Midler*, 849 F.2d at 462.

Laws points to two cases for support. Both cases, however, involve photographs used in advertising, and are distinguishable from this case. In *Downing*, 265 F.3d 994, we held that a claim based on the right of publicity was not preempted by the Copyright Act. In *Downing*, retailer Abercrombie & Fitch was developing a surfing theme--Surf Nekkid--for its subscription catalog. Abercrombie published a photo of the plaintiffs, who were participants in a surf championship in Hawaii in 1965. Abercrombie ran the photo, which it had purchased from the photographer (who held the copyright), and it identified the plaintiffs by name. Abercrombie went well beyond mere republication of the photograph. Without obtaining plaintiffs' consent to use their names and images, it also offered t-shirts exactly like those worn by the plaintiffs in the photo. We noted that the photograph itself was within the subject matter protected by the Copyright Act. But Abercrombie had not merely published the photograph. Rather, it published the photo in connection with a broad surf-themed advertising campaign, identified the plaintiffs-surfers by name, and offered for sale the same t-shirts worn by the plaintiffs in the photo. By doing so, it had suggested that the surfers had endorsed Abercrombie's t-shirts. Accordingly, we concluded that "it is not the publication of the photograph itself, as a creative work of authorship, that is the basis for [plaintiffs'] claims, but rather, it is the use of the [plaintiffs'] likenesses and their names pictured in the published photograph." *Id.* at 1003; *see also Brown*, 201 F.3d at 656-57 (no preemption where the record

company used the names and likenesses of musicians, song writers, and producers on compact disks, tapes, catalogs and posters). We thus concluded that the claim was not within the subject matter of copyright because "[a] person's name or likeness is not a work of authorship within the meaning of 17 U.S.C. § 102." *Downing*, 265 F.3d at 1004.

Laws also relies on a second case, *Toney v. L'Oreal USA*, Inc., 406 F.3d 905 (7th Cir. 2005), in which the Seventh Circuit held that a claim under the Illinois Right of Publicity Act was not preempted by the Copyright Act. Toney was a model who had posed for photographs used to promote hair-care products on packaging and in national advertisements. Defendants owned the copyright for the photograph of Toney that was used, and had a right to use it from November 1995 to November 2000; any other use would be negotiated separately. In apparent violation of their understanding, defendants continued to use the photographs in their advertising beyond 2000. Toney alleged that this use violated her right of publicity under Illinois law. The Seventh Circuit concluded that

> Toney's identity is not fixed in a tangible medium of expression. There is no "work of authorship" at issue in Toney's right of publicity claim. A person's likeness--her persona--is not authored and it is not fixed. The fact that an image of the person might be fixed in a copyrightable photograph does not change this. . . . The fact that the photograph itself could be copyrighted, and that defendants owned the copyright to the photograph that was used, is irrelevant to the [right of publicity] claim. . . .

> The defendants did not have her consent to continue to use the photograph . . . .

Id. at 910. The fact that the photograph was copyrighted could not negate the fact that Toney had reserved artistic control over her image for any period beyond the contractual time frame. The Seventh Circuit concluded that Toney's claim was not preempted.[4]

In contrast, Jennifer Lopez's song "All I Have" incorporated samples of Deborah Laws's "Very Special" and gave her the attribution negotiated by Elektra and Sony. Sony did not use Laws's image, name, or the voice recording in any promotional materials. Her state tort action challenges control of the artistic work itself and could hardly be more closely related to the subject matter of the Copyright Act.

We find more to the point, and quite persuasive, the California Court of Appeal's decision in *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911, 58 Cal. Rptr. 2d 645 (Ct. App. 1996). There, defendant CBS owned the exclusive rights to distribute a motion picture in which plaintiffs performed. A third party who financed the operation of the movie refused to pay plaintiffs their previously agreed-to salaries. Plaintiffs brought suit against CBS alleging, *inter alia*, that by airing the motion picture using their names, pictures, and likenesses without their consent, CBS had violated their statutory right of publicity. The Court of Appeal held that the Copyright Act preempted the action. As the court observed, "it was not merely [plaintiffs'] likenesses which were captured on film--it was their dramatic performances which are . . . copyrightable." *Id.* at 651. "[O]nce

[plaintiffs'] performances were put on film, they became 'dramatic work[s]' 'fixed in [a] tangible medium of expression . . . .' At that point, the performances came within the scope or subject matter of copyright law protection," and the claims were preempted. *Id.* at 650; *see also Downing*, 265 F.3d at 1005 n.4 ("In *Fleet*, the plaintiffs were actors in a copyrighted film. The claims of the plaintiffs were based on their dramatic performance in a film CBS sought to distribute. . . . This is clearly distinguishable from this case where the Appellants' claim is based on the use of their names and likenesses, which are not copyrightable."). In effect, the plaintiffs' right of publicity claim was a question of control over the distribution, display or performance of a movie CBS owned. Since CBS's use of plaintiffs' likenesses did not extend beyond the use of the copyrighted material it held, there was no right of publicity at issue, aside from the actors' performances. Had the court held otherwise, each actor could claim that any showing of the film violated his right to control his image and persona.

Laws makes much of the fact that she possessed a right of first refusal in all future uses of "Very Special" under the original production agreement with Elektra. She contends that this right expressly gives her control over the use of her name and voice in connection with any use of "Very Special." She also contends that "[i]f the copyright holder itself, Elektra/ Asylum, was not ceded such rights, then as a matter of law its licensee does not possess those rights." In effect, Laws contends that her contractual reservation gives her an interest in the copyright and, concomitantly, renders Elektra's copyright partially subject to her control.

We express no view as to the effect of Laws's reservation in the production agreement and no view as to any remedies that Laws may have against Elektra. Whether or not the two parties contracted around the actual use of a copyright does not affect our preemption analysis. To the extent that Laws has enforceable, contractual rights regarding the use of Elektra's copyright, her remedy may lie in a breach of contract claim against Elektra for licensing "Very Special" without her authorization. *See Grosso v. Miramax Film Corp.*, 383 F.3d 965, 968 (9th Cir. 2004).[5]

In sum, we hold that Laws's cause of action is within the subject matter of copyright.

B. *Equivalent Rights*

We must next determine whether the rights she asserts under California law are equivalent to the rights protected under the Copyright Act. We conclude that they are. In *Del Madera Props. v. Rhodes & Gardner*, 820 F.2d 973 (9th Cir. 1987), *overruled on other grounds, Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994), we outlined the test for determining whether state rights were "equivalent" to those under the Copyright Act:

> To satisfy the "equivalent rights" part of the preemption test . . . the . . . alleged misappropriation . . . must be equivalent to rights within the general scope of copyright as specified by section 106 of the Copyright Act. Section 106 provides a copyright owner with the exclusive rights of reproduction, preparation of derivative works, distribution, and display. To

> survive preemption, the state cause of action must protect rights which are qualitatively different from the copyright rights. The state claim must have an extra element which changes the nature of the action.

Id. at 977 (quotations and citations omitted). In *Del Madera Properties*, the plaintiff alleged that the defendants had allegedly misappropriated a copyrighted land map to plan a new development. Plaintiff advanced an unfair competition claim and argued that it was qualitatively different from copyright because the unfair competition claim required the breach of a fiduciary duty, an element not required under copyright. We squarely rejected Del Madera's argument:

> This argument . . . does not add any "extra element" which changes the nature of the action. The argument is constructed upon the premise that the documents and information . . . belonged to Del Madera and were misappropriated by the defendants. Del Madera's ownership of this material, and the alleged misappropriation by the defendants, are part and parcel of the copyright claim.

Id.; see also Harper & Row, Publishers, Inc. v. Nation Enters., 501 F. Supp. 848, 853-54 (S.D.N.Y. 1980) ("[T]he contract claim is redundant because the additional elements . . . do not afford plaintiff rights that are 'different in kind' from those protected by the copyright laws."), *rev'd on other grounds*, 471 U.S. 539, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985).

Laws contends that her right of publicity claim under California Civil Code § 3344 requires proof of a use for a "commercial purpose," which is not an element of a copyright infringement claim. She concedes that a right which is the "equivalent to copyright" is one that is infringed by the mere act of reproduction; however, she argues that her claim is not based on Sony's mere act of reproduction, but "is for the use of . . . Laws'[s] voice, the combination of her voice with another artist, and the commercial exploitation of her voice and name in a different product without her consent."

Sony argues that Laws's claims are based exclusively on the reproduction of "Very Special" in "All I Have." It asserts that the rights protected under Laws's voice misappropriation claim are not qualitatively different from the rights protected under copyright law because the sole basis for her voice misappropriation claim is the unauthorized reproduction of her copyrighted vocal performance.

The essence of Laws's claim is, simply, that she objects to having a sample of "Very Special" used in the Jennifer Lopez-L.L. Cool J recording. But Laws gave up the right to reproduce her voice--at least insofar as it is incorporated in a recording of "Very Special" --when she contracted with Elektra in 1981 and acknowledged that Elektra held the "sole and exclusive right to copyright such master recordings," including the right "to lease, license, convey or otherwise use or dispose of such master recordings." At that point, Laws could have either retained the copyright, or reserved contractual rights in Elektra's use of the recording. Indeed, Laws claims that the latter is precisely what she did. But if Elektra licensed "Very Special" to Sony

in violation of its contract with Laws, her remedy sounds in contract against Elektra, not in tort against Sony.

The mere presence of an additional element ("commercial use") in section 3344 is not enough to qualitatively distinguish Laws's right of publicity claim from a claim in copyright. The extra element must transform the nature of the action. Although the elements of Laws's state law claims may not be identical to the elements in a copyright action, the underlying nature of Laws's state law claims is part and parcel of a copyright claim. *See Fleet*, 58 Cal. Rptr. 2d at 649. Under the Act, a copyright owner has the exclusive right "to reproduce the copyrighted work." 17 U.S.C. § 106(1). Laws's claims are based on the premise that Sony reproduced a sample of "Very Special" for commercial purposes without her permission. But Sony obtained a limited license from the copyright holder to use the copyrighted work for the Lopez album. The additional element of "commercial purpose" does not change the underlying nature of the action. *See Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1239-40 (C.D. Cal. 1987).

IV. CONCLUSION

Both copyright and the right of publicity are means of protecting an individual's investment in his or her artistic labors. As the Court said of copyright:

> The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best

> way to advance public welfare through the talents of authors and inventors in "Science and useful Arts." Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.

Mazer v. Stein, 347 U.S. 201, 219, 74 S. Ct. 460, 98 L. Ed. 630, 1954 Dec. Comm'r Pat. 308 (1954). Similarly, the Supreme Court has said that the

> right of publicity . . . rests on more than a desire to compensate the performer for the time and effort invested in his act; the protection provides an economic incentive for him to make the investment required to produce a performance of interest to the public.

Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 576, 97 S. Ct. 2849, 53 L. Ed. 2d 965 (1977). On the one hand, we recognize that the holder of a copyright does not have "a license to trample on other people's rights." *See* J. Thomas McCarthy, The Rights of Publicity and Privacy § 11:60, at 788 (2d ed. 2005). On the other hand, however, the right of publicity is not a license to limit the copyright holder's rights merely because one disagrees with decisions to license the copyright. We sense that, left to creative legal arguments, the developing right of publicity could easily supplant the copyright scheme. This, Congress has expressly precluded in § 301. Were we to conclude that Laws's voice misappropriation claim was not preempted by the Copyright Act, then virtually every use of a copyrighted sound recording would infringe upon the original performer's right of publicity. We foresaw this distinct possibility in *Sinatra*:

An added clash with the copyright laws is the potential restriction which recognition of performers' "secondary meanings" places upon the potential market of the copyright proprietor. If a proposed licensee must pay each artist who has played or sung the composition and who might therefore claim unfair competition-performer's protection, the licensee may well be discouraged to the point of complete loss of interest.

Sinatra, 435 F.2d at 718. It is hard to imagine how a copyright would remain meaningful if its licensees were potentially subject to suit from any performer anytime the copyrighted material was used.

To be clear, we recognize that not every right of publicity claim is preempted by the Copyright Act. Our holding does not extinguish common law or statutory rights of privacy, publicity, and trade secrets, as well as the general law of defamation and fraud (or any other similar causes of action), so long as those causes of action do not concern the subject matter of copyright and contain qualitatively different elements than those contained in a copyright infringement suit. Elektra copyrighted Laws's performance of "Very Special" and licensed its use to Sony. If Laws wished to retain control of her performance, she should (and may) have either retained the copyright or contracted with the copyright holder, Elektra, to give her control over its licensing. In any event, her remedy, if any, lies in an action against Elektra, not Sony.

We therefore agree with the district court's conclusion that Laws's right of publicity claims are preempted by the Copyright Act. The judgment is

AFFIRMED.

- - - - - - - - - - - - - - Footnotes - - - - - - - - - - - - - -

n1 § 102. Subject matter of copyright: In general (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.

n2 § 103. Subject matter of copyright: Compilations and derivative works (a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully. (b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

n3 § 106. Exclusive rights in copyrighted works Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

n4 *Toney* differs from this case in a significant way: Toney brought her right of publicity claim against L'Oreal U.S.A., Inc., the Wella Corp., and Wella Personal Care of North America, Inc., which each at some point held the copyright and had agreed not to use Toney's likeness after 2000. The facts of this case would be analogous to *Toney* if Laws had brought her right of publicity claim against Elektra, which holds the copyright to the song and may have agreed to licensing limitations. We express no views on the correctness of *Toney* or its application to any claims against Elektra.

n5 Counsel represented to this Court during oral argument that it had in fact filed a breach of contract claim in state court.

CV 03-2038

UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA

DEBRA LAWS, an individual,
Plaintiff,

v.

SONY MUSIC ENTERTAINMENT, INC. dba EPIC RECORDS, a Delaware Corporation; and Does 1 through 50, inclusive,
Defendants.

November 3, 2003, Decided
November 4, 2003, Filed; November 5, 2003, Entered

COUNSEL: For DEBRA LAWS, plaintiff: Rickey G Ivie, Kendall E James, Ivie McNeill & Wyatt, Los Angeles, CA.

For SONY MUSIC ENTERTAINMENT INC dba Epic Records, defendant: David A Steinberg, Matt J Railo, Paul A Guelpa, Mitchell Silberberg & Knupp, Los Angeles, CA.

JUDGES: LOURDES G. BAIRD, United States District Judge.

OPINION BY: LOURDES G. BAIRD

OPINION:

ORDER GRANTING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT

I. INTRODUCTION

This case involves alleged misappropriation of Debra Law's voice and name by Defendant Sony Music Entertainment, Inc. ("Sony") in connection with the sound recording and video entitled "All I Have" performed by Jennifer Lopez. Plaintiff Debra Laws alleges that "All I Have" samples extensively from her 1980 sound recording "Very Special" without Plaintiff's prior consent. Currently before the court is Defendant's Motion for Summary Judgment.

II. FACTUAL AND PROCEDURAL BACKGROUND

Plaintiff alleges that she is a professional vocalist and recording artist who has achieved international acclaim. Declaration of Plaintiff Debra Laws. ("Dec. Laws"), PP 1-5. She first recorded the song "Very Special" in 1981 for Elektra Records. Id. P 2. Since that time, she has continued to perform the song throughout the United States and internationally. Id. PP 5-7.

In 1979, Debra Laws entered into a recording agreement with Sprit Productions (which her brother founded). Declaration of Paul Guelpa ("Dec. Guelpa"), Exh. G; Declaration of Hubert Laws ("Dec. H. Laws"), PP 5-6. That same year, Spirit Productions entered into a production agreement with Elektra Records, a division of Warner Communications. Dec. Guelpa, Exh. F. Spirit Productions agreed to produce master recordings of Debra Laws for Elektra. Id. The agreement specifically gave Elektra the right to

copyright the productions, which Elektra did in 1981. Id. P 4; Supplemental Declaration of Paul Guelpa ("Supp. Dec. Guelpa"), Exh. A. The agreement also granted Elektra the right to license the productions. Id.

On November 26, 2002, Warner licensed to Sony Music a non-exclusive license and right to use a portion of Debra Law's recording of "Very Special" in the song "All I Have" performed by Jennifer Lopez. Dec. Guelpa, Exh. I. The agreement required Sony to include a credit stating "Featuring samples from the Debra Laws recording "Very Special."" Id. at 53.

Sony subsequently released both a music recording and a music video incorporating portions of "Very Special" into "All I Have." Plaintiff alleges that "All I Have" has been a hugely successful recording and music video. Complaint, PP 10-11. Warner did not receive permission from either Elektra or Laws, and neither have received compensation. Dec. H. Laws, P 6; Dec. Laws P 10.

Laws filed an action against Sony on February 20, 2003 in Superior Court for Los Angeles County. Plaintiff brings five causes of action against Defendant Sony: (1) statutory misappropriation of a name or voice for commercial purpose (under *California Civil Code § 3344*); (2) common law invasion of privacy (misappropriation of name or voice); (3) unfair competition (under *California Business and Professions Code § 17200 et seq.*); (4) constructive trust; and (5) preliminary and permanent injunction.

Sony removed the case to this court on March 21, 2003. On March 28, 2003, Defendant sought to have the court join Elektra as a "necessary party" under *Federal Rule of Civil Procedure 19*. The court denied the motion. On

September 22, 2003, Sony filed the summary judgment motion currently before the court. The parties have fully briefed the motion. Plaintiff filed an ex parte motion on October 28, 2003 to extend the summary judgment hearing in order to conduct additional discovery. Defendant filed an opposition on October 29, 2003. By minute order dated October 31, 2003, the court denied the motion. The court now considers the summary judgment motion.

III. LEGAL STANDARDS

Rule 56 of the Federal Rules of Civil Procedure provides that a court shall grant a motion for summary judgment if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." *Fed. R. Civ. P. 56(c)*. Material facts are those that may affect the outcome of the case. *See Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986)*. A dispute as to a material fact is genuine if there is sufficient evidence for a reasonable jury to return a verdict for the nonmoving party. *Id.*

The party moving for summary judgment bears the initial burden of informing the district court the basis of the summary judgment motion, and of demonstrating the absence of a genuine issue of material fact for trial. *See Celotex Corp. v. Catrett, 477 U.S. 317, 323, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986)*; *Katz v. Children's Hosp. of Orange County, 28 F.3d 1520, 1534 (9th Cir. 1994)*. On an issue for which the nonmoving party has the burden of proof at trial, the moving party need only point out "that there is an absence of evidence to

support the nonmoving party's case." *Celotex, 477 U.S. at 325.*

Once this initial burden is satisfied, the non-moving party is required to "go beyond the pleadings and by her own affidavits, or by the depositions, answers to interrogatories, and admissions on file, designate 'specific facts' showing that there is a genuine issue for trial." *Celotex, 477 U.S. at 324* (internal quotations omitted); *see Nilsson, Robbins, Dalgarn, Berliner, Carson & Wurst v. Louisiana Hydrolec, 854 F.2d 1538, 1544 (9th Cir. 1988).* Where the standard of proof at trial is preponderance of the evidence, the non-moving party's evidence must be such that a "fair-minded jury could return a verdict for the [non-moving party] on the evidence presented." *Anderson, 477 U.S. at 252.* The evidence is viewed in the light most favorable to the non-moving party and all justifiable inferences are to be drawn in the non-movants favor. *Id. at 255.*

IV. ANALYSIS

Defendant seeks summary judgment on the following two grounds: 1) Plaintiff's claims are preempted by the Copyright Act of 1976, and 2) Plaintiff's claims are barred by the *First Amendment.* The court initially considers the preemption argument.[1]

A. Preemption

Plaintiff brings only state law claims against Defendant. She does not allege any copyright violations. She contends that "copyright law was not intended to apply to this type of action." Opposition, 10, In 6.

The 1976 Copyright Act extends federal copyright protection to "original works of authorship fixed in any tangible medium of expression." *17 U.S.C. § 102(a).* The Act specifically preempts rights that are equivalent to those within the scope of copyright as specified in the Act. *17 U.S.C. § 301. Section 301 of the Copyright Act* states:

> All legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by *section 106* in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright ... are governed exclusively by this title. No person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State. *17 U.S.C. § 301(a).*

Congress clearly expressed the purpose of this section: "The intention of *Section 301* is to preempt and abolish any rights under the common law or state statutes, that are equivalent to copyright and that extend to works within the Federal Copyright Law." H.R.Rep. No. 1476, 94th Cong., 2d Sess. 130, reprinted in 1976 U.S.C.C.A.N. 5659, 5746.

However, not all state causes of action are preempted. Preemption exists only if 1) the state right is "within the subject matter of copyright" as defined by the Act; and 2) the state right is "equivalent" to any exclusive rights of a federal copyright. *17 U.S.C. § 301(a); Downing v. Abercrombie & Fitch, 265 F.3d 994, 1003 (9th Cir. 2001); Motown Record Corp. v. George A. Hormel & Co., 657 F. Supp. 1236, 1238 (C.D. Cal. 1987).*

At the heart of the current controversy is the issue of whether the claimed rights fall within the subject matter of the Copyright Act. The subject matter of the Copyright Act is described in *17 U.S.C. § § 102and 103.* It includes musical works and sound recordings. *17 U.S.C. § 102.* However, a person's name, voice, likeness and overall persona are not copyrightable. *Fleet v. CBS, Inc., 50 Cal. App. 4th 1911, 1918, 58 Cal. Rptr. 2d 645 (Cal. App. 2d 1996)* ("Civil Code *section 3344* is intended to protect rights which cannot be copyrighted").

Plaintiff contends that her state claims fall outside the scope of the Copyright Act because she is challenging Defendant's unauthorized use of her name and voice, not the use of the sound recordings. Defendant asserts that Plaintiff's voice was fixed in a sound recording, and as such is copyrightable. Therefore, the court must determine whether Defendant's use of Plaintiff's song "Very Special" constituted the use of her voice/name/persona or a sound recording.

The Ninth Circuit has held that the use of a person's voice does not fall under copyright protection and that state law claims are not preempted. *See, Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988); Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1098-1100 (9th Cir. 1992).* However, in those cases, the expropriator had imitated the person's voice without permission. The courts found that a person's voice is more personal than a work of authorship.*Id.* Both courts associated a person's voice with part of her identity. Id. In neither case was the voice "fixed" in a work of authorship. Id.

In other "identity" cases, courts have found common law or state statutory claims not preempted. In Wendt v.

Host International, Inc., the Ninth Circuit reversed a grant of summary judgment. *Wendt, 125 F.3d 806, 811 (9th Cir. 1997).* In so doing, the court acknowledged that actors could bring a common-law right of publicity action against defendants for using animatronic robots that bore some likeness to the actors. Id. The court noted that actors do not lose the right to control the commercial exploitation of their likeness.*Id. See also, White v. Samsung Electronics America, Inc., 971 F.2d 1395 (9th Cir. 1992)* (recognizing state and common law right to publicity action for identity misappropriation).

Similarly, courts have held that claims stemming from the unauthorized use of a photograph are not preempted. *See Downing v. Abercrombie & Fitch, 265 F.3d 994, 1003-1005 (9th Cir. 2001); KNB Enterprises v. Matthews, 78 Cal. App. 4th 362, 92 Cal. Rptr. 2d 713,* 92 Cal. Rtpr. 2d 713 (Cal. App. 2d 2000). These cases also determined that the person's image/identity was being misappropriated, rather than a copyrightable work.*Id.* A person's name, image, and likeness are not protected by the Copyright Act, therefore state law actions were not preempted. Id.

However, when a person's "identity" claims are essentially claims regarding the use of a copyrighted work, then courts have found the state claims to be preempted. In Motown Records, the defendants had run an advertisement which capitalized upon the tune of a Supreme's song and the group's image. *Motown, 657 F. Supp. 1236.* The court held that the state law claims revolved around the unauthorized use of a copyrighted work. *Id.* The state law claims were merely claims for the reproduction, performance, distribution or display of a copyrighted work within the scope of the

Act. Id. As such, the state law claims were preempted. Id.

In Fleet v. CBS, Inc., actors who had not been paid brought several state law claims against the copyright holder of a movie. *Fleet, 50 Cal. App. 4th 1911, 58 Cal. Rptr. 2d 645.* The court found that all of the state law claims were preempted by the Copyright Act because the scope of the medium came within the Copyright Act. Id. The court found that once the appellants' performances were put on film, they became "dramatic works""fixed within a tangible medium of expression" within *section 102* of the Copyright Act. *Fleet, 50 Cal. App. 4th at 1919-1920, 58 Cal. Rptr. 2d 645.*

The plaintiffs in Fleet had clearly stated that "this is not a copyright infringement case." *Fleet, 50 Cal. App. 4th at 1916, 58 Cal. Rptr. 2d 645.* The court commented that although the plaintiffs could call their claim whatever they wanted, "if all they are seeking is to prevent a party from exhibiting a copyrighted work they are making a claim 'equivalent to an exclusive right within the general scope of copyright.'" *Fleet, 50 Cal. App. 4th at 1920, 58 Cal. Rptr. 2d 645.* The court distinguished the case from situations in which other courts had found state law claims not preempted by copyright. *Fleet, 50 Cal. App. 4th at 1921, 58 Cal. Rptr. 2d 645.* In the non-preempted cases, the state-law claims were based upon the use of plaintiff's image or likeness rather than his or her "copyrightable dramatic or musical performance." *Fleet, 50 Cal. App. 4th at 1922, 58 Cal. Rptr. 2d 645.*

The court finds that the facts in this case are more similar to those in*Fleet* and *Motown* than to the facts in the other identity cases. Although Plaintiff claims that

Defendant's use of the song is without permission, Defendant did receive permission (in the form of a license) from the rightful copyright owner. *See* Exh. I.[2] Plaintiff's complaint revolves around the use of her voice in a sound recording. Sound recordings are protected by copyright. *17 U.S.C. § 102.* Defendant used Plaintiff's original voice from the sound recording of "Very Special." Dec. H. Laws, P 8. According to Plaintiff, Defendant used the *original recordings* to avoid compensating Plaintiff for her performance. Id. P 9. In other words, Defendant used Plaintiff's voice by using the copyrightable sound recording that captured that voice.

Although Defendant credits Plaintiff on the song jacket, the court finds that the one, inconspicuous line does not constitute exploitation of Plaintiff's image or identity. In fact, Defendant was complying with its license agreement by including the credit. Exh. I. Therefore, the addition of the name in the credit cannot remove the fact that Plaintiff is essentially contesting the use of a sound recording which is protected by the Copyright Act.

In essence, Plaintiff has failed to show that the use of her voice in a sound recording amounted to the use of her identity. As such, Plaintiff's state law claims are all preempted by the Copyright Act. Indeed were the court to come to the contrary conclusion, then any vocal sound recording would fall outside the parameters of the Copyright Act because of the use of a person's "voice." This contradicts the express intent of Congress to preempt common law or state statutes that extend to works within the Federal Copyright Law. *See supra,* H.R.Rep. No. 1476.

All of Plaintiff's claims against Defendant arise out of Defendant's use, reproduction, and distribution of Law's song "Very Special." In other misappropriation of name and voice cases, courts have found Plaintiff's claims (unfair competition, right to publicity, invasion of privacy) to be preempted by the Copyright Act. *See, Motown, 657 F. Supp. at 1240-1241*; Fleet, 50, Cal. App. 4th 1911, *50 Cal. App. 4th 1911, 58 Cal. Rptr. 2d 645.* Plaintiff has only raised state law claims in her complaint. The court finds that 1) the subject matter of the state law claims fall within the subject matter specified by the Copyright Act and 2) the rights are equivalent to those found in the Copyright Act (reproduction and distribution). Accordingly, Plaintiff's state law claims are preempted. Since no claims exist other than the state law claims, the court finds the *First Amendment* issue moot.

V. CONCLUSION

Based on the foregoing, the court finds that Defendant has shown that no genuine issue of fact exists. Accordingly, Defendant's motion for summary judgment is GRANTED.

IT IS SO ORDERED.

Dated: November 3, 2003

LOURDES G. BAIRD

United States District Judge

Footnotes

n1 The court rejects Plaintiff's contention that Defendant lacks standing to bring a preemption claim. One need not have an ownership interest in a copyright to assert a preemption defense.

n2 Plaintiff relies on language in the contract between Elektra and Spring for the contention that Sony needed Plaintiff's permission to use "Very Special." Exh. F, PP 4, 6(c)(iii). In oral argument. Plaintiff's counsel stated that Laws had reserved the right to her voice. However, the language in the contract states that *Elektra* needs to get *Spring's* consent for certain actions. Laws was not a party to the contract which she asks the Court to rely on. In addition, Laws does not assert breach of contract as one of her claims.

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Filed 7/10/2006
No. 03-57102

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

DEBRA LAWS,
Plaintiff-Appellant,

v.

SONY MUSIC ENTERTAINMENT, INC., d/b/a EPIC RECORDS, a Delaware corporation,
Defendant-Appellee.

No. 03-57 D.C. No. CV-03-02038-LGB Central District of California, Los Angeles

ORDER

Before: FARRIS, FERNANDEZ, and BYBEE, Circuit Judges.

The panel judges have voted to deny appellant's petition for rehearing.

Judge Bybee has voted to deny the petition for rehearing en banc, and Judges Farris and Fernandez have recommended denying the petition for rehearing en banc.

The full court has been advised of the petition for rehearing en banc and no judge has requested a vote on whether to rehear the matter en banc. Fed. R. App. P. 35.

Appellant's petition for rehearing and petition for rehearing en banc, filed June 14, 2006, is DENIED.

TITLE 17 > CHAPTER 3 > § 301

§ 301. Preemption with respect to other laws

(a) On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to—

(1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or

(2) any cause of action arising from undertakings commenced before January 1, 1978;

(3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106; or

(4) State and local landmarks, historic preservation, zoning, or building codes, relating to architectural works protected under section 102 (a)(8).

(c) With respect to sound recordings fixed before February 15, 1972, any rights or remedies under the common law or statutes of any State shall not be

annulled or limited by this title until February 15, 2067. The preemptive provisions of subsection (a) shall apply to any such rights and remedies pertaining to any cause of action arising from undertakings commenced on and after February 15, 2067. Notwithstanding the provisions of section 303, no sound recording fixed before February 15, 1972, shall be subject to copyright under this title before, on, or after February 15, 2067.

(d) Nothing in this title annuls or limits any rights or remedies under any other Federal statute.

(e) The scope of Federal preemption under this section is not affected by the adherence of the United States to the Berne Convention or the satisfaction of obligations of the United States thereunder.

(f)

(1) On or after the effective date set forth in section 610(a) of the Visual Artists Rights Act of 1990, all legal or equitable rights that are equivalent to any of the rights conferred by section 106A with respect to works of visual art to which the rights conferred by section 106A apply are governed exclusively by section 106A and section 113 (d) and the provisions of this title relating to such sections. Thereafter, no person is entitled to any such right or equivalent right in any work of visual art under the common law or statutes of any State.

(2) Nothing in paragraph (1) annuls or limits any rights or remedies under the common law or statutes of any State with respect to—

(A) any cause of action from undertakings commenced before the effective date set forth in section 610(a) of the Visual Artists Rights Act of 1990;

(B) activities violating legal or equitable rights that are not equivalent to any of the rights conferred by section 106A with respect to works of visual art; or

(C) activities violating legal or equitable rights which extend beyond the life of the author.

CALIFORNIA CODES
CIVIL CODE
SECTION 3344-3346

3344. (a) Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof. In addition, in any action brought under this section, the person who violated the section shall be liable to the injured party or parties in an amount equal to the greater of seven hundred fifty dollars ($750) or the actual damages suffered by him or her as a result of the unauthorized use, and any profits from the unauthorized use that are attributable to the use and are not taken into account in computing the actual damages. In establishing such profits, the injured party or parties are required to present proof only of the gross revenue attributable to such use, and the person who violated this section is required to prove his or her deductible expenses.
Punitive damages may also be awarded to the injured party or parties. The prevailing party in any action under this section shall also be entitled to attorney's fees and costs.

(b) As used in this section, "photograph" means any photograph or photographic reproduction, still or moving, or any videotape or live television transmission, of any person, such that the person is readily identifiable.

(1) A person shall be deemed to be readily identifiable

from a photograph when one who views the photograph with the naked eye can reasonably determine that the person depicted in the photograph is the same person who is complaining of its unauthorized use.

(2) If the photograph includes more than one person so identifiable, then the person or persons complaining of the use shall be represented as individuals rather than solely as members of a definable group represented in the photograph. A definable group includes, but is not limited to, the following examples: a crowd at any sporting event, a crowd in any street or public building, the audience at any theatrical or stage production, a glee club, or a baseball team.

(3) A person or persons shall be considered to be represented as members of a definable group if they are represented in the photograph solely as a result of being present at the time the photograph was taken and have not been singled out as individuals in any manner.

(c) Where a photograph or likeness of an employee of the person using the photograph or likeness appearing in the advertisement or other publication prepared by or in behalf of the user is only incidental, and not essential, to the purpose of the publication in which it appears, there shall arise a rebuttable presumption affecting the burden of producing evidence that the failure to obtain the consent of the employee was not a knowing use of the employee's photograph or likeness.

(d) For purposes of this section, a use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required under subdivision (a).

(e) The use of a name, voice, signature, photograph, or likeness in a commercial medium shall not constitute a

use for which consent is required under subdivision (a) solely because the material containing such use is commercially sponsored or contains paid advertising. Rather it shall be a question of fact whether or not the use of the person's name, voice, signature, photograph, or likeness was so directly connected with the commercial sponsorship or with the paid advertising as to constitute a use for which consent is required under subdivision (a).

(f) Nothing in this section shall apply to the owners or employees of any medium used for advertising, including, but not limited to, newspapers, magazines, radio and television networks and stations, cable television systems, billboards, and transit ads, by whom any advertisement or solicitation in violation of this section is published or disseminated, unless it is established that such owners or employees had knowledge of the unauthorized use of the person's name, voice, signature, photograph, or likeness as prohibited by this section.

(g) The remedies provided for in this section are cumulative and shall be in addition to any others provided for by law.

(2)

No. 06-481

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SUPREME COURT, U.S.

In The

Supreme Court of the United States

DEBRA LAWS,

Petitioner,

v.

SONY MUSIC ENTERTAINMENT, INC.,
dba EPIC RECORDS, a Delaware corporation,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Does Section 301 of the Copyright Act (17 U.S.C. § 301) preempt a state law right of publicity claim based solely on the reproduction and distribution of a copyrighted sound recording under license from the copyright holder?

LIST OF PARTIES

The parties to this matter are Petitioner Debra Laws and Respondent Sony Music Entertainment Inc. ("Sony Music"), a Delaware corporation. Sony BMG Music Entertainment ("Sony BMG"), a Delaware general partnership, is the successor in interest to Sony Music. Pursuant to Rule 29.6 of the Rules of the Supreme Court of the United States, Sony BMG certifies that Sony Corporation and Bertelsmann AG are the ultimate corporate parents of Sony BMG, and that Sony Corporation is the only publicly held company owning greater than a 10% interest in Sony BMG.

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PRELIMINARY STATEMENT

The Ninth Circuit restated the traditional two-part test embodied in 17 U.S.C. § 301 and agreed that, "as applied to the facts of this case," Petitioner Debra Laws's ("Laws") claim for violation of the right of publicity was preempted. *Laws v. Sony Music Entertainment, Inc.*, 448 F.3d 1134, 1139 (9th Cir. 2006). The court held that Laws's vocal performance, consensually fixed in a sound recording, was within the subject matter of copyright, and that the rights to reproduce and distribute it, which Laws claimed infringed her right of publicity, were equivalent to exclusive rights of the copyright holder. *See generally* 1 M. & D. Nimmer, *Nimmer On Copyright*, § 1.01[B] (2006 ed.) (preemption analysis under Section 301 consists of two elements: the nature of the rights granted under state law and the nature of the work in which such rights may be claimed).

The petition for a writ of certiorari should be denied because the Ninth Circuit's opinion is not in conflict with its own prior decisions or decisions of other Courts of Appeals, each of which involved claims for the appropriation of an individual's uncopyrightable persona for use in an advertisement, not for the mere reproduction of a specific copyrighted performance under license from the copyright owner. Laws's claim that the Ninth Circuit's decision conflicts with this Court's decision in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), also does not support granting the Petition. *Zacchini* resolved a potential conflict between a state law right of publicity claim and the First Amendment, which is not an issue here, not the preemptive reach of the Copyright Act.

RELEVANT FACTS

The Ninth Circuit opinion fully describes the facts of this case. As relevant here, it was uncontested that Laws recorded a vocal performance of "Very Special" pursuant to her contract with Elektra/Asylum Records (not a party to this action). Elektra/Asylum registered and owned the copyright in that sound recording of "Very Special," and licensed the right to reproduce it to Respondent Sony Music Entertainment Inc. ("Sony Music"). Sony Music reproduced and distributed portions of the sound recording in a phonorecord, and provided credit to Laws pursuant to her contract with Elektra/Asylum.

REASONS TO DENY THE PETITION

I. THERE IS NO CONFLICT BETWEEN THE NINTH CIRCUIT'S DECISION AND THIS COURT'S DECISION IN *ZACCHINI*.

In *Zacchini*, respondent, the operator of a television station, filmed petitioner's entire human cannonball act, despite his refusal to consent, and then telecast the performance on a nightly news program. 433 U.S. at 563-64. Petitioner sued, *inter alia*, for violation of his right of publicity under Ohio law. *Id.*, at 564. This Court's review was limited to "whether the First and Fourteenth Amendments immunized respondent from damages for its alleged infringement of petitioner's state-law 'right of publicity.'" *Id.*, at 565. The Court answered that question in the negative, holding that, under the unique facts of that case, the Constitution did not privilege the press from appropriating and broadcasting, without consent, Zacchini's entire act. *Id.*, at 578-79.

There is no conflict between *Zacchini* and the Ninth Circuit's decision. In *Zacchini*, the performance at issue was not copyrightable, and, therefore, preemption was not an issue before the Court. Conversely, the First Amendment was not the basis for the Ninth Circuit's decision here. Rather, Laws's right of publicity claims were preempted by Section 301 of the Copyright Act because, unlike Zacchini's live act, Laws's vocal performance was fixed in a copyrighted sound recording with her consent, and that work was licensed for reproduction by the copyright owner.[1]

II. THERE IS NO CONFLICT BETWEEN THE NINTH CIRCUIT'S DECISION AND ITS OWN PRIOR DECISIONS AND THOSE OF OTHER COURTS OF APPEALS.

Laws contends that the Ninth Circuit's decision conflicts with a decision of the Seventh Circuit in a case

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[1] Laws argues that "the plaintiff [in *Zacchini*] would have lost under the Ninth Circuit's analysis because the broadcaster owned the copyright to the videotape of the cannonball performance." Pet. at 12. That is incorrect. Since Zacchini's performance was not lawfully recorded, it could not vest copyright in the broadcaster. 17 U.S.C. §§ 301(b) ("works of authorship not fixed in any tangible medium of expression" not preempted), 101 (in order to be "fixed," a work must be embodied in a copy "by or under the authority of the author"). *See* III *P. Goldstein On Copyright*, § 17.17 at 17:169-70 (3d ed. 2006) ("Because the work in issue [in *Zacchini*] was not fixed with the plaintiff's permission, the result would be the same today. . . . Had Zacchini authorized the fixation of his work, he would have forfeited statutory protection for his performance under the Copyright Act."). The Court in *Zacchini* did note that, in the area of patents and copyrights, the states may not "conflict with the operation of the laws in this area passed by Congress." 433 U.S. at 577 n.13, *quoting Kewanee Oil Co. v. Bicron*, 416 U.S. 470, 479 (1974).

involving the advertising use of a likeness, and with two prior decisions of the Ninth Circuit in cases involving vocal *imitators,* also used for advertising purposes. The Ninth Circuit properly distinguished those decisions and, in denying Laws's petition for rehearing or rehearing *en banc,* correctly concluded that its decision was not in conflict with prior decisions of the court.

A. There Is No Conflict between the Ninth Circuit's Decision and Its Prior Decisions in Cases Involving Vocal Imitators.

Laws argues that the Ninth Circuit's decision conflicts with *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), *cert. denied sub nom. Young & Rubicam v. Midler*, 503 U.S. 951 (1992), and *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992), *cert. denied* 506 U.S. 1080 (1993). These cases involved the use of vocal imitators, without the plaintiff's consent, hired specifically to imitate the well-known and distinctive vocal styles of Bette Midler and Tom Waits. There was no reproduction of performances "fixed in a tangible medium" and subject to copyright. In contrast, here, Laws's ***actual*** vocal performance, ***as embodied in a specific consensual and copyright-protected sound recording***, was reproduced under license from the copyright owner.

In *Midler*, Ford Motor Co. and its advertising agency wanted to use a well-known Bette Midler song, "Do You Want to Dance," in a television commercial. 849 F.2d at 461. When the advertising agency was unable to secure Midler's involvement, it hired one of Midler's former backup singers "to 'sound as much as possible like the Bette Midler record.'" *Id.* The court held that Midler's claim for violation of the right of publicity under California

common law was not preempted because the "'[m]ere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible.'" *Id.*, at 462 ("statutory protection for sound recordings . . . would not prevent a separate recording of another performance in which those sounds are imitated"), *quoting* H.R. Rep. No. 94-1476, 94th Cong., 2d Sess., at 106 (1976), *reprinted in* U.S.C.C.A.N. 5659, 5721. In *Waits*, the Ninth Circuit similarly rejected the claim of preemption, distinguishing its facts from situations like those present here: "Waits's claim, like Bette Midler's, is for infringement of voice, ***not for infringement of a copyrightable subject such as sound recording or musical composition***." 978 F.2d at 1100 (emphasis added).

Both *Waits* and *Midler* correctly grounded their decisions on the distinction between a right of publicity claim based on the use of a vocal imitator, and one based on the use of a specific "fixed" copyrighted vocal ***performance*** by the original singer. Because the former does not involve copyrightable subject matter, it does not implicate copyright law and there can be no preemption. Because the latter does involve copyrightable sound recordings and the exercise of a copyright owner's exclusive rights, the reproduction of vocal performance embodied in a sound recording necessarily implicates copyright law and is preempted.

In *Laws*, the Ninth Circuit reiterated this distinction:

> In this case, Laws's voice misappropriation claim is plainly different from the claims in *Midler* and *Waits* and falls within the subject matter of copyright. In contrast to *Midler* and *Waits*, where the licensing party obtained only a license to the song and then imitated the artist's voice, here

> Sony obtained a license to use Laws's recording itself. Sony was not imitating "Very Special" as Laws might have sung it. Rather, it used a portion of "Very Special" as sung by Debra Laws.

448 F.3d at 1140-41. Thus, *Laws* does not conflict with *Midler* and *Waits* for the very reason recognized in those cases and acknowledged and followed by *Laws*.

B. There Is No Conflict between the Ninth Circuit's Decision and the Seventh Circuit's Decision in *Toney*.

Laws also contends that the Ninth Circuit's decision conflicts with *Toney v. L'Oreal, U.S.A., Inc.*, 406 F.3d 905 (7th Cir. 2005). In doing so, Laws ignores that courts have drawn a clear line between cases involving the persona of an individual as used for advertising a commercial product (as in *Toney*) and those involving a particular artistic performance exploited only by the reproduction and distribution of that copyrighted performance (as in *Laws*).

In *Toney*, plaintiff, a model, licensed the use of her likeness for advertisements for hair care products. 406 F.3d at 905. When defendants used plaintiff's likeness beyond the agreed period, she sued, *inter alia*, for violation of her statutory right of publicity under Illinois law. *Id.* In discussing the preemption issue, the court concluded that plaintiff's "persona" was not fixed in a tangible medium of expression and did not come within the subject matter of copyright. *Id.*, at 909-10.

Toney involved the use of plaintiffs' ***likeness*** for advertising purposes, whereas this case involves a specific recorded ***vocal performance***, embodied in a copyrighted sound recording for the purposes of making phonorecords.

Here lies a critical distinction: a person's "likeness" – even when embodied in a copyrighted photograph – is not within the subject matter of copyright, and right of publicity claims based on the use of that likeness are independent of the copyrighted photograph and not preempted. A specific recorded ***vocal performance***, on the other hand, is within the subject matter of copyright, and right of publicity claims based on the mere reproduction of that ***vocal performance*** are identical to copyright claims and are preempted.[2]

That principle was recognized under California law and its rationale explained in *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645 (Cal. Ct. App. 1996). Plaintiffs were actors whose performances were embodied in a copyrighted film. *Id.*, at 646. The actors were not paid fully for their performances, and brought an action for violation of their rights of publicity against CBS, which had acquired the copyright in the film and had telecast it. *Id.*, at 647. In holding that the actors' right of publicity claims were preempted, the court noted that, because a particular dramatic performance in a motion picture is copyrightable, actions based solely upon the exploitation of the copyrighted work embodying that performance are preempted.

> Appellants insist that neither of [the Section 301 conditions] is met and that their claims pose no threat to the federal scheme because a person's name, voice, likeness, and overall persona are

[2] The reproduction of Laws's recorded performance by Sony Music is analogous to the owner of a copyrighted photograph licensing it for reproduction and distribution in a book of photographs. Clearly, any claim for invasion of the right of publicity under those circumstances would be preempted.

> not copyrightable and assertion of these rights cannot be equivalent to those that fall under the Act's protection. We agree that as a general proposition Civil Code section 3344 is intended to protect rights which cannot be copyrighted and that claims made under its provisions are usually not preempted. But appellants' analysis crumbles in the face of one obvious fact: ***their individual performances in the film White Dragon were copyrightable***.... Here, ... ***it was not merely appellants' likenesses which were captured on film*** – it was their dramatic performances which are ... copyrightable.

Id., at 650 (emphasis added). The court concluded that "[a] claim asserted to prevent nothing more than the reproduction, performance, distribution, or display of a dramatic performance captured on film is subsumed by copyright law and preempted." *Id.*, at 653. *See also KNB Enters. v. Matthews*, 92 Cal. Rptr. 2d 713, 721 (Cal. Ct. App. 2000) ("*Fleet* stands for the solid proposition that performers in a copyrighted film may not use their statutory right of publicity to prevent the exclusive copyright holder from distributing the film.").

In *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001), the Ninth Circuit recognized this distinction:

> In *Fleet*, the plaintiffs were actors in a copyrighted film. The claims of the plaintiffs were based on their ***dramatic performance*** in a film CBS sought to distribute.... [The facts of *Fleet* are] clearly distinguishable from this case where the Appellants' claim is based on the use of their names and likenesses, which are not copyrightable.

265 F.3d at 1005 n.4 (emphasis added). The other cases relied on by Laws (Pet. at 10) also have followed this rationale. *See Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 621, 623 (6th Cir. 2000) (claim for violation of Lanham Act by use of plaintiff's likeness in an action figure was not preempted, noting that plaintiff was "not claiming the right of publicity in order to gain rights in the telecast of his performance, or to contest Fox's right to create derivative works from its copyrighted work in general."); *Wendt v. Host International, Inc.*, 125 F.3d 806, 810 (9th Cir. 1997) (holding right of publicity claim for use of likeness in robotic figures not preempted because plaintiffs "are not seeking to prevent Paramount from exhibiting its copyrighted work[.]"), *cert. denied sub nom. Paramount Pictures Corp. v. Wendt*, 531 U.S. 811 (2000); *Brown v. Ames*, 201 F.3d 654, 660-61 (5th Cir. 2000), *cert. denied sub nom. Collectibles, Inc. v. Brown*, 531 U.S. 925 (2000) (holding claim for unauthorized use of name and likeness on recordings in which defendant and his licensee did ***not*** own the copyrights not preempted, and observing, "[o]nly if states allowed similar claims against authorized publishers or distributors of a work (whether through copyright or the public domain) would the purposes of the Copyright Act be adversely affected"); *see also Daboub v. Gibbons*, 42 F.3d 285, 289 (5th Cir. 1995) (state law claims based on wrongful copying, distribution, and performance of copyrighted lyrics was preempted).

This dispositive distinction between cases involving the intrinsic use of a particular fixed performance, such as in *Laws* and *Fleet*, and cases involving the unauthorized advertising use of a persona through a likeness, such as in *Downing* and *Toney*, is endorsed by the leading copyright treatise:

> [*Fleet*] presented a similar posture [as *Toney*], but with a crucial difference. . . . By upholding

> the baseline proposition that a "right is equivalent to rights within the exclusive province of copyright when it is infringed by the mere act of reproducing, performing, distributing, or displaying the work at issue," the court vindicated the "obvious conclusion that a party who does not hold the copyright in a performance captured on film cannot prevent the one who does from exploiting it by resort to state law."

1 M. & D. Nimmer, *Nimmer On Copyright*, § 1.101[B][1][c], at 1-28.2 to 1-29 (2006 ed.).

The Ninth Circuit recognized and applied the law as discussed above:

> Abercrombie went well beyond mere republication of the photograph. . . . We noted [in *Downing*] that the photograph itself was within the subject matter protected by the Copyright Act. But [defendant] Abercrombie had not merely published the photograph. Rather, it published the photo in connection with a broad surf-themed advertising campaign, identified the plaintiffs-surfers by name, and offered for sale the same t-shirts worn by the plaintiffs in the photo. By doing so, it had suggested that the surfers had endorsed Abercrombie's t-shirts. Accordingly, we concluded that "it is not the publication of the photograph itself, as a creative work of authorship, that is the basis for [plaintiffs'] claims, but rather, it is the use of plaintiffs' likenesses and their names pictured in the published photograph."

Laws, 448 F.3d at 1141, *quoting Downing*, 265 F.3d at 1003. The court later compared these facts to the different facts of *Fleet*, which it found "more on point":

> In effect [in *Fleet*] plaintiffs' right of publicity claim was a question of control over the distribution, display or performance of a movie CBS owned. Since CBS' use of plaintiffs' likeness did not extend beyond the use of the copyrighted material it held, there was no right of publicity at issue, aside from the actors' performances. Had the court held otherwise, each actor could claim that any showing of the film violated his right to control his image and persona.

448 F.3d at 1143.

The Ninth Circuit was careful to limit its decision that Laws's claims were preempted to the specific facts before it, *id.*, at 1139, and acknowledged that under its reasoning "not every right of publicity claim is preempted by the Copyright Act." *Id.*, at 1145. In particular, as noted above, the court recognized that the cases relied on by Laws involved a persona used in advertisements and that "Sony did not use Laws's image, name or voice recording in any promotional materials." *Id.*, at 1142. By contrast, in *Toney*, the court found invasion of the right of publicity by use of the plaintiff's identity on packaging of and advertising for a product, holding that "[t]he basis of a right of publicity claim concerns the message – whether the plaintiff endorses, or appears to endorse, the product in question." 406 F.3d at 910. Laws has never cited a case where the right of publicity was violated merely by the use of a copyrighted work, as authorized by the copyright owner, for its own intrinsic purpose and in a non-advertising context. *See Brown*, 201 F.3d at 660 ("currently . . . no state seems to have" a law that permits right of publicity "claims against authorized publishers or distributors of a work").

Sony Music did no more than reproduce and distribute (under authority of the acknowledged copyright owner), a copyrighted work embodying Laws's performance. For that reason, Laws's "state tort action ***challenges control of the artistic work itself*** and could hardly be more closely related to the subject matter of the Copyright Act." 448 F.3d at 1142 (emphasis added).

C. The Ninth Circuit's Decision Is Consistent with the Policy of the Copyright Law as Enunciated by This Court.

If Laws's position is sustained, the policy of uniformity of the laws governing copyrighted works that dictate federal preemption would be turned on its head. *See* H.R. Rep. No. 94-1476, 94th Cong., 2d Sess., at 130 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5746 (noting "unqualified intention that Congress shall act preemptively, and to avoid any vague borderline areas between state and federal protection"). *See also Daboub*, 42 F.3d at 288 ("Section 301(b) accomplishes the general federal policy of creating a uniform method for protecting and enforcing certain rights in intellectual property by preempting other claims"). This is a particular danger in the context of the right of publicity, for the following reasons: First, a number of states have not recognized the right of publicity. *See ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 928 n.13 (6th Cir. 2003) ("Approximately half of the states have adopted some form of the right of publicity either at common law or by statute"). Second, the scope of protection provided by others states varies, including whether voice is protectible at all under the right of publicity. *Compare, e.g.*, Mass Gen. L. ch. 214, § 3A (voice not protected) *with* Tex. Stat. § 26.011 (voice protected). Third, state laws differ in other material respects, including, for example, the type of use that violates the right of publicity, the nature of exceptions

or exemptions, the duration of the right, and whether the right is descendable and, if so, for what term. Under Laws's construct, the unfettered ability of a copyright holder to exploit his or her exclusive rights would be subject to these vagaries and would change from state to state.

Additionally, under Laws's reasoning, instead of taking precedence over state law claims, federal copyright protection would become subservient to myriad state law claims that could be invoked to prevent copyright owners and their licensees from freely exploiting the works in which they invested and which they own or control. As the Ninth Circuit correctly observed,

> [T]he right of publicity is not a license to limit the copyright holder's rights merely because one disagrees with decisions to license the copyright. We sense that, left to creative legal arguments, the developing right of publicity could easily supplant the copyright scheme. . . . It is hard to imagine how a copyright would remain meaningful if its licensees were potentially subject to suit from any performer anytime the copyrighted material was used.

Laws, 448 F.3d at 1145.[3] Ultimately, if there is no preemption under the facts presented here, owners of copyrights

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[3] The court explained that Laws (or any other performer) was not without remedy, as she could have contracted (as she claimed to have done) to limit the copyright owner's right to reproduce her performance. *See* H.R. Rep. No. 94-1476, 94th Cong., 2d Sess., at 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748 ("Nothing in the bill derogates from the rights of the parties to contract with each other and to sue for breaches of contract"). The court did not opine on the merits of such a claim but noted that, under those circumstances, Laws's claim would be against her contracting party, Elektra/Asylum, not the licensee of the copyright, Sony Music. 448 F.3d at 1145. *See Fleet*, 58 Cal. Rptr. 2d at 651 ("an actor who wishes to protect the use of the image contained in a single, fixed dramatic performance need simply retain the copyright").

would be handcuffed from exploiting their copyrighted works for the very purpose for which they were created, and the transfer of copyrights would be severely impeded. As a result, the preeminent goal of the copyright law – to benefit the public by encouraging creativity – would be stifled. *See, e.g., Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) ("The immediate effect of our copyright law is to secure a fair return to an author's creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good."); *Eldred v. Ashcroft*, 537 U.S. 186, 212 n.18 (2003) ("copyright law serves public ends by providing individuals with an incentive to pursue private ones").

CONCLUSION

It is respectfully submitted that the Petition for Certiorari should be denied.

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(3)

No. 06-481

IN THE

Supreme Court of the United States

DEBRA LAWS, PETITIONER

v.

SONY MUSIC ENTERTAINMENT, INC., D/B/A EPIC RECORDS, A DELAWARE CORPORATION, RESPONDENT

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITIONER'S REPLY BRIEF

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I. RESPONDENT'S OPPOSITION FAILS TO PROVIDE ANY REASON WHY CERTIORARI SHOULD NOT BE GRANTED BY THIS COURT

A. The Seventh Circuit's Decision In Toney Cannot Be Reconciled With The Ninth Circuit's Decision In Laws Concerning the Right of Publicity

Respondent's Opposition attempts to distinguish the holding in *Toney v. L'Oreal*, 406 F.3d 905 (7th Cir. 2005) from *Laws v. Sony Music Entertainment, Inc., 448 F.3d 1134 (9th Cir. 2006)* in a manner that simply does not exist. In *Toney*, the Court clearly decided that an individual's persona is not "'a "writing" of an "author" within the meaning of the copyright clause of the Constitution'" and it is not fixed under Section 301 of the Copyright Act. *Toney*, 406 F.3d at 909, quoting *Downing v. Abercrombie & Fitch*, 295 F.3d 994, 1003-04 (9th Cir. 2001). The fact that an image or voice of a person is fixed in a copyrightable medium of expression does not alter this conclusion. Under *Toney*, the fact that an individual (e.g. actor, athlete, model or singer) consented to be the subject of a copyrighted work is not a factor in the preemption analysis. Rather, the scope of the individual's consent is only relevant to the question of whether a claim for violation of the right of publicity has been established.

Under *Toney*, the right of publicity is treated no differently than a state cause of action for defamation. It is universally accepted that an author cannot write false statements about an individual and assert copyright preemption as a defense. Likewise, under *Toney*, in an action for breach of the right of publicity, the fact that the work is copyrighted would not preempt the claim, and the

scope of the subject's consent would be a matter of an affirmative defense.

Conversely, the Ninth Circuit's holding in *Laws* stands for just the opposite proposition. Illustrative of the Court's holding, Respondent states at p.7, footnote 2 of the Opposition:

> "The reproduction of Laws's recorded performance by Sony Music is analogous to the owner of a copyrighted photograph licensing it for reproduction and distribution in a book of photographs. Clearly, any claim for invasion of the right of publicity under those circumstances would be preempted."

Thus, under the *Laws* holding, a photographer that obtains a person's consent to have his or her picture taken for a high school year book could then sell or license the photograph for use in a pornographic magazine or for posting on an internet porn site and the individual's right of publicity claim would be preempted. This conclusion necessarily follows because under *Laws* the individual consented to be the subject of the photograph, the photographer owned the copyright, and the use was for reproduction and distribution. Under *Toney* an opposite result would be reached because an individual's persona (likeness or voice) is not fixed or authored within the meaning of §301 of the Copyright Act. Thus, the individual's right of publicity claim would not be preempted.

Respondent makes a further effort to distinguish *Toney* by arguing that *Toney* involved infringement by advertisement whereas Laws involved infringement by "reproduction and distribution". Respondent's Opposition, p.6. However, this argument fails because it

completely lacks any statutory basis. Nowhere in Section 301 of the Copyright Act is there any mention of the relevance of the use of the work, such as advertising. Under Section 301, preemption applies in any situation where the facts come within the terms of the section. Thus, the distinction argued by Respondent based on use for advertising is wholly irrelevant.

B. Strong Policy Considerations of National Importance Warrant Review of the Laws Decision By This Court To Provide Proper Guidance To Lower Courts Concerning the Scope And Breadth Of Section 301 of the Copyright Act As It Applies To Right Of Publicity Claims

Copyright laws were designed to protect the copyright holders' monopoly to prevent others from exploiting a work. The Right of Publicity does not clash with this goal. See Schuyler M. Moore, *Straightening Out Copyright Preemption*, U.C.L.A. Entertainment Law Review (2002). Copyright laws were not intended to infringe on other equally important rights not recognized by Copyright Law. The thrust of Respondent's argument is that the right of publicity should simply be eliminated altogether. This is clearly not the intent of copyright preemption. If the right of publicity is to exist in the 9th Circuit the decision in *Laws* must be overturned.

The conflict between the *Laws* and *Toney* decisions threatens to destabilize exploitation of copyrights far more than the minor differences between the various states' right of publicity laws. Both the artist and the copyright holder now have uncertainty whether other circuits will follow *Laws* or *Toney*. Indeed, the conflict which this case illustrates is even wider than *Laws* and

Toney when you consider the number of cases which have held in favor of a finding of no preemption under similar circumstances (i.e., *Toney*, *Downing*, *Wendt v. Host International, Inc.*, 125 F.3d 806 (9th Cir. 1997), *Midler v. Ford Motor Company*, 849 F.2d 460 (9th Cir. 1988) and *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) cert. denied, 506 U.S. 1080 (1993)) as opposed to the cases which have held in favor of a finding of preemption (i.e., *Laws*, *Baltimore Orioles v. Major League Baseball Players Ass'n.*, 805 F.2d 663 (7th Cir. 1986) and *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645 (1996)). This conflict will likely increase the tension between artists and copyright holders as they compete to have their agreements come under the jurisdiction of the circuit most favorable to their respective interests.

CONCLUSION

For all of the foregoing reasons, Petitioner Laws respectfully requests that this Court grant this Petition for Writ of Certiorari.

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